

## REMARKS

Claims 1-7 and 9-22 are pending in the application. Claims 4 and 10 have been withdrawn as being directed to a non-elected species (Species B). Claims 16-22 have been withdrawn as being directed to a non-elected invention (Group III). In the Office Action mailed December 15, 2008, claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Pat. App. Pub. No. 2003/0017424 (Park et al.; hereinafter "Park"). Claims 5-7, 9, and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Park in view of U.S. Pat. App. Pub. No. 2003/0095170 (Johnson). Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Park in view of Johnson and further in view of U.S. Pat. App. No. 6,517,995 (Jacobson et al.; hereinafter "Jacobson").

### **I. Rejections under 35 U.S.C. 102(e)**

Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by Park. The Applicants respectfully traverse the rejections. The Applicants' invention differs from the teaching of Park in at least the manner in which the bow is created in the first surface of the Applicants. In particular, in the Applicants' invention, the bow in the first surface is created by a controlled difference in air pressure between the two sides of the surface [Specification at least at paragraphs [0022]-[0024]]. As discussed in the Applicants' Specification, this aspect of the Applicants' invention represents an improvement over the prior art because the air pressure difference between the two surfaces is directly controlled [Specification at paragraph [0023]]. In contrast, Park teaches only bowing the imprint master by "conventional mechanical methods" [Park at paragraph [0027], of which the only example taught by Park is "a roller" [Park at paragraph [0028]. Park does not teach bowing the first surface in a controlled manner *by application of a controlled air pressure difference between the two sides of the first surface.*

In order to more particularly point out and claim this aspect of the Applicants' invention, the Applicants have herein amended independent claim 1 to recite that the step of bowing the flexible first surface is performed in a controlled manner by application of a controlled air pressure difference between the two sides of the first surface. Support for this amendment is found in the Specification at least at paragraphs [0009] and [0022]-[0024], in the Abstract, in Fig. 1, and in original claim 3. No new matter has been added by this amendment, entry of which is respectfully requested. As previously discussed, Park fails to teach bowing the first

surface in a controlled manner by application of a controlled air pressure difference between the two sides of the first surface. Because Park fails to teach bowing the first surface in a controlled manner by application of a controlled air pressure difference between the two sides of the first surface, as claimed by the Applicants in amended claim 1, Park fails to anticipate or make obvious the Applicants' claimed invention, whether taken alone or in combination, as does all other art of record. The deficiencies of Park are not cured by any other art of record. Reconsideration and withdrawal of the rejections of claim 1, as amended, is therefore respectfully requested.

Claim 3 has been cancelled. Because claim 2 depends from currently amended independent claim 1, which is in condition for allowance, claim 2 is also in condition for allowance. Reconsideration and withdrawal of the rejection of claim 2 is therefore respectfully requested.

## **II. Response to rejections under 35 U.S.C. 103(a)**

Claims 5-7, 9, and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Park in view of Johnson. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Park in view of Johnson and further in view of Jacobson. The Applicants respectfully traverse the rejections. The claimed invention is not unpatentable, because the art of record fails to teach bowing the stamp in a controlled manner by application of a directly controlled air pressure difference between the two sides of the stamp.

As discussed in Section I, in the Applicants' invention, the bow in the stamp is created by a controlled difference in pressure between the two sides of the surface [Specification at least at paragraphs [0022]-[0024]]. In order to more particularly point out and claim this aspect of the Applicants' invention, the Applicants have herein amended independent claim 5 to recite that the step of creating a pattern in the thin film of material by bringing a stamp into contact with the offset substrate is performed by bowing the flexible stamp in a controlled manner by application of a controlled air pressure difference between the two sides of the first surface. Support for this amendment is found in the Specification at least at paragraphs [0009] and [0022]-[0024], in the Abstract, in original claim 9, and in Fig. 1. No new matter has been added by this amendment, entry of which is respectfully requested. No new matter is added by these amendments, entry of which is respectfully requested.

As discussed in Section I, Park fails to teach bowing the stamp in a controlled manner by application of a controlled air pressure difference between the two sides of the stamp. Because Park fails to teach bowing the stamp in a controlled manner by application of a controlled air pressure difference between the two sides of the stamp, as claimed by the Applicants in amended claim 5, Park fails to anticipate or make obvious the Applicants' claimed invention, whether taken alone or in combination, as does all other art of record. These deficiencies of Park are not cured by Johnson, Jacobson, or any other art of record. Reconsideration and withdrawal of the rejections of claim 5, as amended, is therefore respectfully requested.

Claim 9 has been cancelled. Because claims 6, 7, and 11-15 depend from currently amended independent claim 5, which is in condition for allowance, claims 6, 7, and 11-15 are also in condition for allowance. Reconsideration and withdrawal of the rejection of claims 6, 7, and 11-15 is therefore respectfully requested.

With respect specifically to the rejection of claim 6, the rejection of claim 6 acknowledges that "Park et al. as modified [by Johnson] fail to specifically mention the values of the contact angles of the surfaces in question" but goes on to add "However, one having ordinary skill in the art would recognize that utilizing surfaces with different contact angles will facilitate pattern transfer and would have been motivated to modify Park et al. ... in order to facilitate the pattern transfer process." In the response filed 8/13/2008, the Applicants interpreted this rejection as taking "Official Notice" that this element is "notoriously well known in the art" and requested that a specific reference be provided to support this finding with adequate evidence. In response, the present Office Action cites U.S. Pat. App. Pub. No. 2003/0138570 (Kaylor et al.; hereinafter "Kaylor") as teaching "that the receiving medium should have a smaller contact angle in order to get 'efficient and/or substantial transfer' between the two media" [12/15/2008 Office Action at paragraph 20].

Treating the rejection of claim 6 as being a rejection under 35 U.S.C. 103(a) over Park in view of Johnson and further in view of Kaylor, the Applicant's invention is not obvious over Park in view of Johnson in combination with Kaylor or any other art of record, because (1) combination of Kaylor with Parks and Johnson to obtain the invention claimed in the Applicants' claim 6 would change the principle of operation of Kaylor, and (2) combination of Kaylor with Parks and Johnson to obtain the invention claimed in the Applicants' claim 6 renders Kaylor unsatisfactory for its intended purpose.

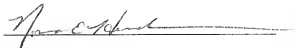
The Applicant's invention is not obvious over Parks in view of Johnson in combination with Kaylor or any other art of record, because combination of Kaylor with Parks and Johnson to obtain the invention claimed in the Applicants' claim 6 would change the principle of operation of Kaylor. In the Applicants' claimed invention, the stamp prints the film that was previously applied to the offset substrate, with unwanted film being removed from the offset substrate onto the stamp by action of the stamp in order to create the desired pattern. No fluid is transferred from the stamp to the substrate. In contrast, Kaylor teaches a gravure cylinder that transfers receptor fluid to a substrate. The principles of operation of Kaylor and the Applicant's invention are clearly diametrically opposed- while Kaylor teaches applying fluid to the substrate, the Applicants' claimed invention requires that film be removed from the substrate. To use Kaylor in the manner proposed by the rejection would therefore change the principle of operation of Kaylor. As outlined in MPEP 2143.01 (VI), "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious." For this reason, the combination of Kaylor with Park in view of Johnson does not make the invention of the Applicant obvious. Reconsideration and withdrawal of the rejection of claim 6 is therefore respectfully requested.

The Applicant's invention is also not obvious over Parks in view of Johnson in combination with Kaylor or any other art of record, because combination of Kaylor with Parks and Johnson to obtain the invention claimed in the Applicants' claim 6 renders Kaylor unsatisfactory for its intended purpose. As discussed previously, the claimed invention of the Applicants requires that the stamp remove film from the offset substrate. The teaching of Kaylor requires the opposite- that fluid be applied to the substrate, rather than that it be removed. Clearly, it cannot then be possible for the teaching of Kaylor to be used for its intended purpose if it is used as proposed and as required by the Applicants' claimed invention. Using Kaylor in the invention of the Applicant would therefore render the method of Kaylor unsuitable for its intended purpose. The MPEP states at 2143.01(V) that if "the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." For this reason, the combination of Kaylor with Park in view of Johnson is not permissible and does not make the invention of the Applicant obvious. Reconsideration and withdrawal of the rejection of claim 6 is therefore respectfully requested.

### **III. Conclusion**

Claims 1-7 and 9-22 are pending in the application. Claims 4, 10, and 16-22 are withdrawn. Claims 3 and 9 have been cancelled. Claims 1 and 5 have been amended. The Applicants respectfully submit that claims 1, 2, 5-7, and 11-15 are in condition for allowance, which action is therefore requested. The Applicants further believe that this application is now in condition for allowance, which action is now earnestly and respectfully solicited. Should there remain any unresolved issues, it is respectfully requested that the Examiner telephone Norma E. Henderson, Applicant's Attorney, at 603-437-4400, so that such issues may be resolved as expeditiously as possible.

Respectfully Submitted,



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Date

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